<u>REMARKS</u>

Claims 1-21 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I.   <u>Rejection of Claims 1-21 Under 35 U.S.C. §101</u>

Claims 1-21 stand rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed toward non-statutory subject matter. More specifically, the Examiner asserts that independent claims 1, 10, 16, and 21 provide no physical transformation, nor is any useful, concrete, or tangible result produced. It is respectfully requested that rejection of these claims be withdrawn for at least the following reason. Claims 1, 10, 16, and 21 recite statutory subject matter as they produce a useful, concrete, and tangible result such to be classified as patentable subject matter according to 35 U.S.C. §101.

> Because the claimed process applies the Boolean principle [abstract idea] ***to produce a useful, concrete, tangible result*** ... on its face the claimed process comfortably falls within the scope of §101. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed.Cir. 1999) (Emphasis added); *See State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998). The inquiry into patentability requires an examination of the contested claims to see if the claimed subject matter, as a whole, is a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea," or if the mathematical concept has been ***reduced to some practical application rendering it "useful."*** *AT&T* at 1357 *citing In re Alappat*, 33 F.3d 1526, 31 1544, 31 U.S.P.Q.2D (BNA) 1545, 1557 (Fed. Cir. 1994) (Emphasis added) (holding that more than an abstract idea was claimed because the claimed invention as a whole was directed toward forming a specific machine that produced the useful, concrete, and tangible result of a smooth waveform display).

Independent claim 1 (and similarly independent claims 16 and 21) recites *a computer-implemented system that test loads a server comprising a dynamic load adjustor component that **dynamically adjusts user characteristics** based at least in part on a browser type, for **distribution thereof as a percentage of total requests sent to a server being load tested**.* This result of dynamically adjusting user characteristics is both concrete and tangible as adjustment of such characteristics would naturally modify the

state of the affected computer-implemented system and can consistently do so based on the certain characteristics. Also, the functionality of dynamically adjusting user characteristics mitigates the need for an administrator or human entity to perform such adjustment, and thus renders the claimed subject matter useful as well. In this same way, using these characteristics to control distribution of requests when test loading a server, as recited in the subject claims, is also useful, concrete, and tangible. Thus, in view of controlling case law, these claims encompass statutory subject matter.

Moreover, as a guideline for showing utility, MPEP § 2106 provides "[r]egardless of the form of statement of utility, *it must enable one ordinarily skilled in the art to understand why the applicant believes the claimed invention is useful*." The aforementioned utility of mitigating human intervention would be easily understood by one having ordinary skill in the art. The Specification asserts multiple practical utilities including "scenarios can include a plurality of test mixes, load profiles and user profiles that are statistically determined based on records of web logs." Providing a computer-implemented system to perform such tasks exhibits practical utility and one having ordinary skill – *e.g.* one who would be responsible for manually creating such scenarios in absence of the claimed subject matter – would undoubtedly find such practical utility in the claims as recited. In view of at least the foregoing, the subject matter recited in independent claims 1, 16, and 21, as well as claims 2-9 and 17-20 which respectively depend therefrom, satisfy the utility guidelines and also produce a useful, concrete, and tangible result that falls within the scope of 35 U.S.C. § 101.

Furthermore, the Examiner repeatedly recites that the claims fail to produce a physical transformation. The Federal Circuit has held, and indeed the MPEP also provides, that a physical transformation "is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application." MPEP § 2106, *quoting AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358-59. Thus a physical transformation is not required; rather only a useful, concrete, and tangible result as shown above. Also, the Examiner asserts that the result produced must be communicated to a user, displayed, or stored in any tangible form for later use or access. The Examiner has provided no support for this assertion, and in fact, no support exists in law or procedure. Even so, one having ordinary skill in the art would

recognize that the claimed subject matter uses the scenarios and user characteristics to test load a server, and such a result is extremely useful to an administrator testing the sufficiency of a server in a given environment. Thus, the result is communicated to the administrator in this way. Again, the utility is evaluated from the standpoint of one having ordinary skill in the art and in light of the specification. For at least these reasons, the subject matter as claimed exhibits practical utility as described above, and thus this rejection should be withdrawn.

Additionally, the Examiner asserts that claim 10 is rejected under 35 U.S.C. §101 for the same reasons. It is requested that this rejection be withdrawn for at least the following reason. Claim 10 recites a result that is useful, concrete, and tangible as well. The useful result recited in claim 10 is a scenario that loads a server based on user profiles to simulate server requests that are typical of users within an environment; the scenario is produced by an execution engine. Because the scenario comprises user profile information used to test load a server, the scenario that is generated is concrete and tangible. The fact that the scenario can *load a server via a plurality of users* is also concrete and tangible as such loading will modify the state of the server. Again, this result is also useful as the scenario and the loading thereof, help simulate a real-world usage environment for a server to determine how the server will handle a plurality of requests in the typical usage pattern. Also, the scenario is created automatically without the need for total human intervention. One having ordinary skill would appreciate the utility of claim 10 at least in this automation aspect. In view of the useful, concrete, and tangible result produced by claim 10 and the Federal Circuit opinion handed down in *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358, rejection of this claim, as well as claims 11-15 which depend therefrom, under 35 U.S.C. §101 should be withdrawn as well.

Applicants' representative also reminds Examiner that claims 1, 10, 16, and 21, if evaluated as pertaining to software code, are still patentable in light of recent Federal Circuit opinion in *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1338 (Fed. Cir. 2005), wherein the court stated:

> Title 35, section 101, explains that an invention includes 'any new and useful process, machine, manufacture or composition of matter.' Without question, *software code alone* qualifies as an invention eligible for patenting under these categories, at least as processes. (emphasis added) (citations omitted).

This case further emphasizes that any new useful process, machine, *etc.*, is a patentable invention such as the claimed subject matter as shown above. The opinion also affirms that if claims 1, 10, 16, and 21 are viewed as software code, the subject matter as recited undeniably falls within the bounds of this holding. Additionally, the Examiner asserts that this holding does not apply to applicants' claims because the claims in *Eolas* provide a result communicated to the user. However, the matter of the claims in *Eolas* is of no consequence to the blanket statement that software code alone is patentable. Had the Federal Circuit meant to apply the statement to only the claims at issue in that case, they would have stated such. In fact, the court subsequently stated that, "[t]he patented invention in this case is such a software product," thus applying the specific facts of the case to the general rule recited above. Thus, it is evident that this statement made by the court was meant to stand independently. Therefore, in view of at least the foregoing, rejection of all independent claims, and associated dependent claims, under 35 U.S.C. §101, whether or not pertaining to software code, is preemptive, and thus, should be withdrawn.

<u>CONCLUSION</u>

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP637US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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